

Remarks

Claims 1, 7-11, and 26-39 are in the case. Claims 1 and 7-11 stand rejected. The grounds of rejection are traversed. New claims 26-39 are presented for consideration. No new matter has been introduced by the claim amendments, support for which is found in the detailed description and in the drawings.

Claim Rejections – 35 U.S.C. § 102(b)

Claims 1-9 and 11 are rejected under 35 U.S.C. 102 (b) under four different references. Applicant traverses on grounds that a prima facie showing of anticipation has not been established.

Claims 2-6, which originally depended directly or indirectly from claim 1, have been incorporated into claim 1. In applicant's view, the Examiner's interpretation of the meaning of "closed perimeter hole" in the lower/second jaw and "slit" in upper/first jaw does not give adequate weight to applicant's use of the foregoing terms in applicant's specification. Claims must be read in view of the specification, of which they are a part. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). Applicant is of the view that when these claim limitations are properly interpreted in view of applicant's specification, none of the four cited references establishes a prima facie showing of anticipation. Nonetheless, applicant has elected to more specifically claim the configurations of the holes in order to more specifically incorporate the teachings of applicant's specification.

Anticipation under 35 USC 102(b) requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindermann Maschinenfabrick GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984); MPEP § 2131. The prior art reference must be such that a person of ordinary skill in the field of the invention would consider there to be no difference between the claimed invention and the reference disclosure. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ.2d 1001, 1010 (Fed. Cir. 1991). Additionally, the prior art reference under 35 USC 102(b) must be enabling, thus placing the allegedly disclosed matter in the

possession of the public. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ.2d 1241, 1245 (Fed. Cir. 1986). Because the cited references do not disclose each and every element of the claimed invention, applicant respectfully suggests that a prima facie showing of anticipation has not been established as to claims 1-9 and 11.

Claims 1-8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Thal (US 2002/0103493). Applicant respectfully traverses on grounds that the Commissioner has not met its burden of establishing a prima facie showing of anticipation. The Examiner takes the position that Thal discloses a surgical instrument comprising a handle (32, 42), a body portion (22), and a jaw portion (14, 18) comprising first and second jaws for gripping tissue. With reference to Figure 6, the Examiner takes the position that the second, lower jaw has a closed perimeter hole extending through. With reference to Figure 7, the Examiner takes the position that the first jaw has a slit, consisting of the narrow channel that is opposite the body portion. Applicant either disagrees with or does not understand the Examiner's interpretation of Thal, and requests clarification. It does not appear to applicant that Figure 7 shows a slot according to the claimed invention. The only slot-like structure that applicant can discern in Thal Figure 7 is blocked by an enclosed lengthwise passage 132 that has an enlarged head portion 135, as can be seen also in Thal Figures 5 and 6. Thus, as far as applicant can determine, Thal would not enable the claimed invention, in which through-holes in the upper and lower jaws allow a suture thread to pass through the upper and lower surfaces of the jaws, and in which an open slot on the upper jaw allows the suture thread to pass out of the through-hole on the upper jaw.

Claims 1-8 and 11 are also rejected under 35 U.S.C. 102(b) as being anticipated by Nolan et al. (USPN 5,776,150). The Examiner takes the position that Nolan discloses a surgical instrument comprising a handle (14, 12), a body portion (20), and a jaw portion (30) comprising first and second jaws for gripping tissue. With reference to Figure 3, the Examiner interprets the second, lower jaw as having a closed perimeter hole extending through at pin 46. The first jaw has a slit (27) that is opposite the body portion. The first jaw has a center hole (40) that is in communication with the slit. The slit is narrower than the center hole.

Applicant disagrees with the foregoing interpretation of Nolan. Nolan's hole for pivot pin 46 is not a closed perimeter through-hole of the type described in applicant's specification and claimed in Claim 1. Thus, at least one element of applicant's claimed invention is not found in

Nolan. Accordingly, applicant respectfully traverses on grounds that the Commissioner has not met its burden of establishing a prima facie showing of anticipation.

Claims 1-8 and 11 are further rejected under 35 U.S.C. 102(b) as being anticipated by Fogarty et al. (USPN 6,228,104). Applicant traverses on grounds that, as far as applicant can determine, Fogarty does not teach a lower jaw having a closed perimeter hole extending between upper and lower surfaces, and an upper jaw having an open slit communicating with a through-hole that extends between upper and lower surfaces. Applicant requests that Fogarty be reinterpreted in view of applicant's specification. Further, the instrument of Fogarty differs in function from that of the claimed invention, and as such cannot be considered to enable the claimed invention.

Claims 1, 2, 7, 8, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi et al. (USPN 6,273,887). Applicant traverses on grounds that, as far as applicant can determine, Yamauchi does not teach a lower jaw having a closed perimeter hole extending between upper and lower surfaces, and an upper jaw having an open slit communicating with a through-hole that extends between upper and lower surfaces. Applicant requests that Yamauchi be reinterpreted in view of applicant's specification. Further, the instrument of Yamauchi differs in function from that of the claimed invention, and as such cannot be considered to enable the claimed invention.

Claim Rejections – 35 U.S.C. § 103(a)

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thal in view of Heimberger et al. (USPN 5,562,699). Claim 10 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Nolan in view of Heimberger et al. (USPN 5,562,699).

The Examiner takes the position that Thal and Nolan both disclose the invention substantially as claimed. The Examiner admits that Thai and Nolan do not disclose a handle having an overpressure linkage. The Examiner takes the position that Heimberger discloses a surgical apparatus comprising a handle portion, a body portion and a jaw portion for gripping tissue. Heimberger further discloses a force transfer and limiting member operatively connecting the handle to the jaws for transmitting and limiting user-applied force to prevent damage to the tissue being treated (Col 1, lines 45-Col 2, line 5). The Examiner concludes that it would have

been obvious to one having ordinary skill in the art at the time of the invention to incorporate a limiting element into the handle of the surgical jaws in order to prevent damage to the patient's tissue.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991); MPEP § 2142.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant suggests that the Examiner has not made a *prima facie* case as to claim 10 because, as discussed above, neither Thal nor Nolan in combination with Heimberger teaches or suggests all the claim limitations, including without limitation through-holes in the upper and lower jaws, and an open slot in the upper jaw to allow a suture thread to pass out of the through-hole in the upper jaw.

In addition to the absence of a teaching of all of the claimed elements, it is unclear to applicant how the cited reference motivate the combination of the claimed invention. The Examiner states that Heimberger offers the motivation, but does not explain how, other than to state generally that "the inventions are analogous with each other and the instant invention and therefore the combination is proper." However, in order to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The present case is similar to *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). In *In re Dembiczak*, the claims were drawn to a generally round, orange plastic trash bag with a jack o'lantern face imprinted thereon. The claims were initially rejected as obvious in

view of conventional trash bags in combination with a reference showing a jack o’lantern face on an orange paper bag stuffed with newspapers. However, the Federal Circuit reversed, finding that there was no suggestion or motivation to combine the cited references. In establishing the nonobviousness of Dembiczak’s invention, the Federal Circuit noted the following concerns about application of the “suggestion to combine” requirement:

Our analysis begins in the text of section 103 quoted above, with the phrase ‘at the time the invention was made.’ For it is this phrase that guards against entry into the ‘tempting but forbidden zone of hindsight,’ see *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873, 228 U.S.P.Q. (BNA) 90, 98 (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 U.S.P.Q.2D (BNA) 1097 (Fed. Cir. 1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 313 (Fed. Cir. 1983). *Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’ Id.*

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. . . . Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.

Id., 175 F.3d at 998-999 (emphasis added); see also MPEP §§ 2142, 2143.01.

In this case, as in *Dembiczak*, the Examiner has not made “particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.” *Id.*, 175 F.3d at 1000. The Examiner simply states that it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate a limiting element into the handle of the surgical jaws in order to prevent damage to the patient's tissue. Until the Examiner particularly identifies a suggestion, teaching, or motivation to modify Thal or Nolan to arrive at the claimed invention, it is respectfully suggested that the Examiner has not supported a *prima facie* case of obviousness as to claim 1. See *Dembiczak*, 175 F.3d at 1000; MPEP § 2142.

Conclusion

Applicant suggests claims 1, 7-11 and 26-39 are now in a condition for allowance. It is believed that this response has been filed within the applicable time period for responding and that no extension of time is therefore required, but if an extension is required, applicant hereby requests an appropriate extension of time. It is further believed that no fees are due, but if any fees or credits are due, the Commissioner is authorized to charge or deposit them to Deposit Account No. 502795.

Respectfully submitted,

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